

### **REMARKS**

Claims 1-8 and 25-28 have been amended and new Claims 31-40 have been added. Support for these amendments and the new claims can be found throughout the specification. No new matter has been added thereby. Claims 9-13 and 29-30 have been canceled without prejudice to Applicants' right to pursue these claims at a later date or in a continuation, continuation-in-part or divisional application. Claims 14-24 were previously canceled. Accordingly, Claims 1-8, 25-28 and 31-40 are presently pending. Claims 1 and 31 are independent claims.

Applicants thank the Examiner for withdrawing the finality of the previous Office Action and for finding Applicants' arguments regarding U.S. Patent No. 3,998,702 to Opoku ("Opoku") somewhat persuasive in light of previously presented Claims 1-13 and 25-30.

#### **35 U.S.C. § 103(a): Claims 1-13 and 25-30**

The Examiner rejected claims 1-13 and 25-30 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,800,116 to Stevens *et al.* ("Stevens *et al.*") in further view of Opoku.

#### **Preclusion of Use of Stevens *et al.* as Prior Art**

The Examiner cited Stevens *et al.* as a prior art reference under 35 U.S.C. § 103(a). Applicants submit that, under 35 U.S.C. § 103(c), Stevens *et al.* cannot properly be cited as a prior art reference to preclude patentability of the present application. Section 103(c)(1) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The assignment of U.S. Patent Application No. 10/196,942 ("the '942 application"), which ultimately issued as the Stevens *et al.* patent, was recorded with the U.S. Patent and Trademark Office on July 18, 2002 and assigned the '942 application to the present application's assignee, Suncor Energy Inc. See Reel 013115, Frame 0375. The present application was filed on April

16, 2004 and claims priority to Canadian Patent Application No. 2,455,011, filed on January 9, 2004.

The Stevens *et al.* patent issued on October 5, 2004. The '942 application was published on January 22, 2004 as U.S. Patent Application Publication No. 2004/0011201. Since the '942 application was first published after the earliest claimed priority date of the present application, it does not qualify as prior art under 35 U.S.C. §§ 102(a) or 102(b). Thus the '942 application, and the Stevens *et al.* patent that issued therefrom, only qualifies as prior art under 35 U.S.C. § 102(e). Since Section 103(c) provides that subject matter developed by another person qualifying as prior art only under Section 102(e) does not preclude patentability under Section 103 if the subject matter and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person at the time the claimed invention was made, Stevens *et al.* cannot properly be cited by the Examiner as a prior art reference to preclude patentability of the present invention under Section 103(a). Applicants therefore request that the Examiner withdraw the rejection based on Stevens *et al.*

#### Opoku

The Examiner's rejections of Claims 1-13 and 25-30 under 35 U.S.C. § 103(a) are overcome by the arguments above regarding Stevens *et al.* standing alone. However, Applicants nonetheless wish to further clarify some of the differences between Opoku and amended Claim 1.

Opoku discloses a deaerating conduit 14, where the lower or bottom zone of the conduit has steam injection means 34 which can be one or more pipes having a plurality of openings or nozzles 37 disposed over the upper surface thereof. *See* col. 3, lines 37-47. Opoku further discloses a novel launder 43 and a plurality of steam injection means 46 along the bottom which communicate with steam conduit 48 via inlet means 45. *See* col. 4, lines 25-37. Opoku also discloses that steam added to the bituminous froth is allowed to escape from the deaerating conduit 14. For example, Figure 2 includes "exit means 33 which permits steam and air to separately vent from the conduit." *See* col. 3, lines 45-47. In addition, the apparatus disclosed in Opoku is gravity-based. *See, e.g.,* col. 3, lines 3-4; col. 3, lines 10-12; col. 5, lines 20-23.

By contrast, Applicants' apparatus forces both the bitumen froth and the steam through an enclosed passageway under pressure to form a heated feed, as claimed in amended Claim 1.

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Unlike Opoku, Applicants' apparatus does not employ a gravity-based system open to the air that allows steam to escape thereinto.

#### Dependent Claims

Claims 2-8 and 25-28 all depend directly or indirectly upon independent Claim 1. For the reasons explained above, Stevens *et al.* and Opoku also cannot properly be combined to render these claims obvious.

Claims 9-13 and 29-30 have been canceled, and thus rejection of these claims is now moot.

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

### **CONCLUSION**

In view of the foregoing, the present application is believed to be fully in condition for allowance. However, should any remaining impediments to allowance be identified by the Examiner, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number appearing below.

Because December 20, 2008 was a Saturday, this response is timely submitted with a three-month extension fee. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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Respectfully submitted,

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